01203DIV2

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: :

Tristan BARBEYRON et al. : EXAMINER: PATTERSON, C.L.

SERIAL NO.: 09/988,201 : GROUP ART UNIT: 1652

FILED: November 19, 2001 :

FOR: GLYCOSYL HYDROLASE GENES AND THEIR USE FOR PRODUCING ENZYMES FOR THE BIO-DEGRADATION OF CARRAGEENANS

RESPONSE TO RESTRICTION REQUIREMENT

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

Sir:

This is in response to the requirement for restriction that was made under 35 U.S.C. §§121 on September 11, 2003.

The Office has required restriction in the present application as follows:

Group I, claims 12-18, drawn to a nucleic acid of SEQ ID NO:5 and a nucleic acid encoding a protein of SEQ ID NO:6, a vector containing the nucleic acid, a host cell containing the nucleic acid and a method of making an enzyme by using the host cell.

Group II, claims 12-18, drawn to a nucleic acid of SEQ ID NO:7 and a nucleic acid encoding a protein of SEQ ID NO:8, a vector containing the nucleic acid, a host cell containing the nucleic acid and a method of making an enzyme by using the host cell.

Furthermore, the Examiner notes that claim 17 of either USSN 09/988,200 or USSN 09/988,202, limited to either SEQ ID NO: 5 or 7, could be examined with this application.

Applicants hereby elect to prosecute, with traverse, the invention of Group I, claims

LAW OFFICES
DENNISON, SCHULTZ & DOUGHERTY
612 CRYSTAL SQUARE 4
1745 JEFFERSON DAVIS HIGHWAY
ARLINGTON, VIRGINIA 22202-3417
703 412-1155

12-18, drawn to a nucleic acid of SEQ ID NO:5 and a nucleic acid encoding a protein of SEQ ID NO:6, a vector containing the nucleic acid, a host cell containing the nucleic acid and a method of making an enzyme by using the host cell.

Applicants also note that new claims 19 and 20 added by a Supplemental Preliminary Amendment in the above-identified application on July 17, 2003, should be properly examined along with claims 12-18.

Applicants' election is made with traverse for the following reasons:

Under U.S. practice, restriction of an application is proper only if the claims of the restricted groups are either independent or patentably distinct, and there is a burden in searching the entire application. 35 U.S.C. §121; MPEP §803.

Applicants respectfully traverse the restriction requirement on the grounds that the Office has not provided adequate reasons and/or examples to support its conclusion of patentable distinctness or shown that a burden exists in searching all the claims.

The Office has characterized the inventions of Groups I and II as distinct because the "nucleic acids of SEQ ID NO:5 and 7 are structurally different products and are patentably distinct." 3rd paragraph from the bottom of page 2 of the Office Action. While Applicants take note that nucleotide sequences encoding different proteins are structurally different chemical compounds and would normally constitute independent and distinct inventions within the meaning of 35 U.S.C. 121, as stated in MPEP §803.04, the Commissioner has partially waived the requirements of 37 C.F.R. 1.141 *et seq.* to permit a "reasonable number" of such nucleotide sequences to be claimed in a single application. See *Examination of Patent Applications Containing Nucleotide Sequences*, 1192 O.G. 68 (November 19, 1996).



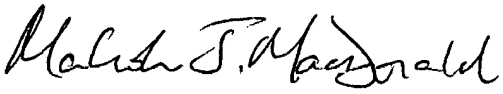
LAW OFFICES
DENNISON, SCHULTZ & DOUGHERTY
612 CRYSTAL SQUARE 4
1745 JEFFERSON DAVIS HIGHWAY
ARLINGTON, VIRGINIA 22202-3417
703 412-1155

As noted in MPEP §803.04, up to ten nucleotide sequences constitute a reasonable number for examination purposes, and must be examined in a single application without restriction. Accordingly, a mere structural difference of the claimed nucleotide sequences is not a valid basis for restriction. The restriction requirement is therefore believed to be improper, and it should be withdrawn.

Applicants also respectfully traverse the restriction requirement on the grounds that the Office has not shown even a *prima facie* case that a serious burden would be placed on the Examiner if the inventions of Groups I and II were to be examined together. Accordingly, since it has not been shown by the Office that a serious burden would be placed on the Examiner if the inventions of Groups I and II were to be examined together, Applicants submit that restriction cannot be properly maintained between Groups I and II. The restriction requirement is clearly improper, and it should be withdrawn.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice of such action is earnestly solicited.

Respectfully submitted



October 3, 2003

Malcolm J. MacDonald
Reg. No. 40,250
Tel: (703) 412-1155 Ex. 24

LAW OFFICES
DENNISON, SCHULTZ & DOUGHERTY
612 CRYSTAL SQUARE 4
1745 JEFFERSON DAVIS HIGHWAY
ARLINGTON, VIRGINIA 22202-3417
703 412-1155